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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,788	08/08/2001	Arthur Yuichi Tsubaki	1348-1010	2798

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EXAMINER	
ELAHEE, MD S	
ART UNIT	**PAPER NUMBER**
2645	

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/924,788	TSUBAKI ET AL.	
	Examiner	Art Unit	
	Md S. Elahee	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Examiner has received an after final amendment and additional declaration from Mr. Lawrence R. Youst filed on 10/03/05. Examiner does not agree with the arguments in the remarks of the amendment that the evidence submitted overcomes the effective date of the Barnett et al. (U.S. Pub. No. 2001/0006892) reference. The reasons are shown below. However, examiner has performed an updated search and found a new prior art reference Barnett et al. (U.S. Patent No. 6,192,223) which has an early invention back to **July 29, 1997**. In light of the reference, examiner has made another ground of rejection of all the independent claims in view of Barnett of U.S. Patent No. 6,192,223 in addition to previous rejection.

Response to Argument

2. The complete claimed invention was not conceived prior to the date of the Barnett reference because Exhibit A or B filed on 01/24/2005 and Exhibit C or D or E or H or I filed on 10/03/2005 fails to support all the limitations of claims 1-52. There is no support at least for example, of having a database of frequency data including operating frequencies and geographic locations of a plurality of transmitting parties. Lawrence R. Youst stated that Mr. Tsubaki's notebook and declaration establish conception, however as stated above each limitation was not conceived with the provided exhibits.

3. There is insufficient diligence from a time prior to the date of the Barnett reference to June 2001.

The submitted Exhibits are sufficient to only show diligence from June, 2001 to the filing date of the application.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 10, 21, 29, 38 and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al. (U.S. Patent No. 6,192,223).

Regarding claim 1, Barnett teaches a receiver that receives radio frequency transmissions at a plurality of discrete frequencies (abstract; fig.6; col.2, lines 15-18).

Barnett further teaches a database of frequency data including operating frequencies and geographic locations of a plurality of transmitting parties (abstract; col.2, lines 9-14, 35-37, 45-47, 61-67, col.3, lines 1-4).

Barnett further teaches a host system [i.e., position locator circuit] that identifies the location of the receiver (col.4, lines 24-29, col.5, lines 47-49).

Barnett further teaches a parse engine 36 [i.e., compiler circuit] that identifies transmitting parties of interest from the plurality of transmitting parties based upon the location of the receiver (fig.3, 4; col.8, lines 5-38).

Barnett further teaches a memory that stores frequency data corresponding to the transmitting parties of interest (col.2, lines 15-21).

Barnett further teaches a processing circuit coupled to the receiver, the database, the host system, the parse engine 36 and the memory that provides the location of the receiver to the compiler circuit, stores the frequency data in the memory and controls the receiver to monitor transmissions at the frequencies of the transmitting parties of interest (abstract; fig.3, 6; col.2, lines 15-30, col.4, lines 24-29, col.5, lines 47-49, col.8, lines 5-24, col.10, lines 23-35).

Regarding claim 10 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Barnett teaches a communication device that communicates locally with a host system [i.e., position locating device] that identifies the location of the receiver (col.2, lines 9-14, 35-37, 45-47, col.4, lines 24-29, col.5, lines 47-49).

Regarding claim 21 is rejected for the same reasons as discussed above with respect to claims 1 and 10.

Regarding claim 29 is rejected for the same reasons as discussed above with respect to claims 1 and 21.

Regarding claim 38 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Barnett teaches maintaining a data base [i.e., non remote database] of frequency data including operating frequencies and geographic locations of a plurality of transmitting parties (abstract; col.2, lines 9-14, 35-37, 45-47, 61-67, col.3, lines 1-4).

Regarding claim 52 is rejected for the same reasons as discussed above with respect to claims 1 and 38.

6. Claims 1-17, 19-25, 27-34, 36-41 and 43-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al. (U.S. Pub. No. 2001/0006892).

Regarding claim 1, Barnett teaches a receiver that receives radio frequency transmissions at a plurality of discrete frequencies (abstract; fig.6; page 1, paragraph 0011, page 2, paragraph 0015).

Barnett further teaches a database of frequency data including operating frequencies and geographic locations of a plurality of transmitting parties (abstract; page 1, paragraphs 0011-0013, page 2, paragraph 0015).

Barnett further teaches a host system (i.e., position locator circuit) that identifies the location of the receiver (page 3, paragraph 0038, page 4, paragraph 0046).

Barnett further teaches a parse engine 36 (i.e., compiler circuit) that identifies transmitting parties of interest from the plurality of transmitting parties based upon the location of the receiver (fig.3, 4; page 5, paragraphs 0061, 0062).

Barnett further teaches a memory that stores frequency data corresponding to the transmitting parties of interest (page 1, paragraphs 0011, 0012, page 2, paragraphs 0014, 0015).

Barnett further teaches a processing circuit coupled to the receiver, the database, the host system, the parse engine 36 and the memory that provides the location of the receiver to the compiler circuit, stores the frequency data in the memory and controls the receiver to monitor transmissions at the frequencies of the transmitting parties of interest (abstract; fig.3, 6; page 1, paragraph 0011-page 2, paragraph 0015, page 3, paragraph 0038, page 4, paragraph 0046, page 5, paragraph 0061, page 6, paragraph 0083).

Regarding claims 2, 11 and 39, Barnett teaches that the database of frequency data is stored within a second memory internal to the frequency scanning radio receiver (page 9, paragraph 0109).

Regarding claims 3, 12 and 40, Barnett teaches that the database of frequency data is stored on a memory device that is removably insertable into the frequency scanning radio receiver (page 9, paragraph 0109).

Regarding claims 4, 13 and 45, Barnett teaches that the database of frequency data further comprises frequency data relating to at least one usage type (page 9, paragraph 0109).

Regarding claims 5, 14, 22 and 30, Barnett teaches that the position locator circuit is a GPS based circuit (fig.3; page 3, paragraph 0038, page4, paragraph 0052).

Regarding claims 6, 15, 23 and 31, Barnett teaches that the position locator circuit is a cellular network based circuit (fig.3; page 3, paragraph 0038, page4, paragraph 0052).

Regarding claims 7, 16, 24 and 32, Barnett teaches that an input device coupled to the processing circuit (fig.6; page 7, paragraph 0086).

Regarding claims 8 and 33, Barnett teaches that the position locator circuit receives position information input into the input device (fig.6; page 7, paragraph 0086).

Regarding claims 9, 17, 25, 34 and 51, Barnett teaches that a display coupled to the processing circuit that displays identification data relating to the transmitting parties of interest (fig.6; page 7, paragraph 0087).

Regarding claim 10 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Barnett teaches a communication device that communicates locally with a

host system (i.e., position locating device) that identifies the location of the receiver (page 1, paragraphs 0011, 0013, 0016, page 3, paragraphs 0037, 0038, page 4, paragraph 0046).

Regarding claims 19, 27 and 36, Barnett teaches that the communication device communicates via short range radio communication (page 1, paragraphs 0011, 0012, 0014, 0015).

Regarding claims 20, 28 and 37, Barnett teaches that the communication device is coupled to the position locating device via a data cable (fig.1; page 3, paragraphs 0037, 0038).

Regarding claim 21 is rejected for the same reasons as discussed above with respect to claims 1 and 10.

Regarding claim 29 is rejected for the same reasons as discussed above with respect to claims 1 and 21.

Regarding claim 38 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Barnett teaches maintaining a data base (i.e., non remote database) of frequency data including operating frequencies and geographic locations of a plurality of transmitting parties (abstract; page 1, paragraphs 0011- 0013, page 2, paragraph 0015).

Regarding claim 41, Barnett teaches that maintaining the data base (i.e., non remote database) of frequency data in a local device communicably coupled to the frequency scanning radio receiver (page 1, paragraphs 0011- 0013, page 2, paragraph 0015, page 9, paragraph 0109).

Regarding claim 43 is rejected for the same reasons as discussed above with respect to claim 19. Furthermore, Barnett further teaches communicating between the host system device (i.e., local device) and the frequency scanning radio receiver (fig.1; page 3, paragraph 0038).

Regarding claim 44 is rejected for the same reasons as discussed above with respect to claims 20 and 43.

Regarding claims 46 and 47 are rejected for the same reasons as discussed above with respect to claims 1 and 5.

Regarding claims 48 and 49 are rejected for the same reasons as discussed above with respect to claims 1 and 6.

Regarding claim 50 is rejected for the same reasons as discussed above with respect to claims 1 and 8.

Regarding claim 52 is rejected for the same reasons as discussed above with respect to claims 1 and 38.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 18, 26, 35 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett et al. (U.S. Pub. No. 2001/0006892) and in view of Lyons (U.S. Patent No. 6,282,412).

Regarding claims 18, 26, 35 and 42, Barnett does not specifically teach "the communication device communicates via infrared communication". Lyons teaches that the communication device communicates via infrared communication (col.3, lines 57-65). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barnett to allow the communication device communicating via infrared communication as taught by Lyons. The motivation for the modification is to have doing so in order to allow data to be entered into the memory from modem remotely using a known data transmission protocol.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Honda (U.S. Patent No. 5,734,973) teach Radio receiver for selectively receiving signals at frequencies of previously stored broadcast stations, Schwob (U.S. Patent No. 4,969,209) teach Broadcast receiver capable of selecting stations based upon geographical

location and program format and Ahlemeyer et al. (U.S. Patent No. 4,888,815) teach Scanning radio receiver.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.E.
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December 12, 2005

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